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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/621,677	07/24/2000	Guy Nathan	871-85	6899

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EXAMINER

SALTARELLI, DOMINIC D

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/621,677

Applicant(s)

NATHAN, GUY

Examiner

Dominic D Saltarelli

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/357,762.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3.5</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to because legends should be provided to readily identify the features of the drawings, see MPEP § 608.02(o). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (5,355,302, of record) [Martin] in view of Wilder (5,408,417).

Regarding claim 4, Martin discloses an audiovisual reproduction system (fig. 1, jukebox 13) consisting of a central unit (fig. 1, processing circuit 121, col. 5, lines 26-41) controlling display means (fig. 1, visual display 125, col. 5, lines 45-46), memory means (fig. 1, ROM 121B, RAM 121C, and storage 93), and a telecommunications modem (fig. 1, modem 19) connected to a distribution network (fig. 1, distribution network 15) controlled by a host server (fig. 1, central management system 11) through an operating system (software program contained in ROM, col. 5, lines 26-31) comprising a library of tools and services (the operating system controls all features and functions of the jukebox, including the graphical display, money collection, and song selection, and data collection, fig. 5 and col. 6 line 59 – col. 7 line 17), wherein the operating system of the reproduction system automatically sends a request to the host server requesting that selected songs be downloaded (customer requests for new songs, col. 5 line 60 – col. 6 line 7), each song being determined as a function of the answers to a questionnaire (prompt for new song requests) which is stored in a file in the memory means to be displayed by display means at the appropriate moment (col. 7, lines 10-

17), and to which users reply by actions on a user interface (entered using a keyboard).

Martin fails to disclose the operating system is a multitask operating system and the use of a touch screen.

Examiner takes Official Notice that it is old and well known to utilize multitask operating systems for controlling dynamic digital systems, as such operating systems are optimized for concurrent execution of multiple tasks, thus enabling systems which are capable of multiple tasks to perform them simultaneously, optimizing the performance and usefulness of the system.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Wilder to include a multitask operating system, for the benefit of optimizing the performance and usefulness of the audiovisual reproduction system.

In an analogous art, Wilder teaches an audiovisual reproduction system with a touch screen for user selections (col. 4, lines 13-22), providing an intuitive form of user selections from a very flexible interface.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Martin to include a touch screen, as taught by Wilder, for the benefit of providing an intuitive form of user selections of requested songs from a very flexible user interface.

Regarding claim 5, Martin and Wilder disclose the audiovisual reproduction system of claim 4, wherein the reproduction system downloads a list of songs on the host server through the information distribution network (song catalog updates, col. 5, lines 8-25 and col. 6, lines 19-30), the host server then downloading the songs in the list prepared by the operator into the memory means of a determined audiovisual reproduction system through the same network (song library updates, col. 5, lines 8-25 and col. 6, lines 30-34).

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin and Wilder as applied to claim 4 above, and further in view of Kalis et al. (6,212,138) [Kalis].

Regarding claim 6, Martin and Wilder disclose the system of claim 4, wherein the host server (Martin, fig. 1, central manager 11) sends commands which program the reproduction system (Martin, fig. 1, jukebox 13) remotely (col. 5, lines 60-63 and col. 6, lines 48-54), but fail to disclose sending orders which are memorized by the reproduction system and used to play particular songs at particular moments.

In an analogous art, Kalis teaches programming a jukebox to play particular songs at particular moments (col. 10, lines 30-64), advantageously providing for a more flexible jukebox.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system disclosed by Martin and Wilder to include

programming the reproduction system to play particular songs at particular moments, as taught by Kalis, for the benefit of providing a more flexible audiovisual reproduction system.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 4-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-6 of U.S. Patent No. 6,336,219. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different descriptions of the same subject matter, varying in breadth.

a. The "Audiovisual reproduction system" in line 1, claim 4 of the instant application corresponds to the "Digital jukebox system according to claim 1" in line 1, claim 4 of patent # 6,336,219.

b. The "touch screen" in lines 2-3 and line 14 of claim 4 of the instant application corresponds to the "interactive interface" in lines 2 and 12 of claim 4 of patent # 6,336,219.

It would have been obvious at the time to a person of ordinary skill in the art to readily recognize that the conflicting claims are different descriptions of the same subject matter, varying in breadth.

Claims 5 and 6 of the instant application correspond to claims 5 and 6 of patent # 6,336,219 because said claims in both the instant application and patent # 6,336,219 are different descriptions of the same subject matter varying in breadth.

Conclusion

7. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) _____ - _____ on _____
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Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D Saltarelli whose telephone number is (703) 305-8660. The examiner can normally be reached on M-F 10-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dominic Saltarelli
Patent Examiner
Art Unit 2611

DS


HAITRAN
PATENT EXAMINER